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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,931	08/29/2006	Eduardo Luis Salva Calcagno	P70495USD	2587
136 7590 09/22/2008 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER VAUGHAN, MICHAEL R				
ART UNIT 2131		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/584,931

**Applicant(s)**SALVA CALCAGNO, EDUARDO  
LUIS**Examiner**

MICHAEL R. VAUGHAN

**Art Unit**

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 1,3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9-22-06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The instant application having Application No. 10/584931 filed on 7/05/06 is presented for examination by the examiner.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

#### ***Claim Objections***

Claims 1, 3, and 4 are objected to because of the following informalities:

Per Claim 1, "data base" should be "database";

pg. 26, line 21: the data lacks antecedent basis. Examiner suggests this point to said bar code.

Pg. 27, lines 1-5, the server, the verification result, the result, and the network server all lacks antecedent basis.

Pg. 27, line 1, the word shows is a bit ambiguous. From the specification it appears this could be a literal translation from the foreign language and here the word "prints" would be more appropriate in the context of the bar code and its result being printed in the form of a bar code and passed between the server and the database computer.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, according the Applicant's spec on page 17, starting at line 13,

Once the data has been transferred means of bar codes, the Web Server prints on a roll of wafers the bar code with NICK + PIN information and a laser reader connected to the Authorization Center database reads the bar code barras and verifies that the NICK is qualified..."

It is unclear from the claim language, what "the data" refers too. Examiner assumes that "the data" is the printed bar code sent from the authorization center network server. However, the claim language is not concise with the specification because this server is referred to as a Web Server in the specification and as a authorization center network

server in the claim. It is also unclear if the data is the printed bar code of the data being retrieved from the database. Applicant should amend the claim language to be consistent with the specification.

Claim 1 is incomplete for omitting essential steps, such omission amounting to a gap between the steps. Relying on the specification above, it is essential for the database to be disconnected from the outside world. Applicant is very clear about this feature as a component of the security of this method. In light of that fact, the claim should be clear about how the laser reader reads the bar code. The step of printing the converted Nick and Pin to a barcode is omitted and therefore makes the claim hard to understand exactly how the converted bar code gets to and is read by the database since the database is disconnect from the network. Adding this step and clarifying which data is being read would rectify the confusion. See MPEP § 2172.01.

Claim 2 recites the limitation "the system" in lines 14 and 16. There is insufficient antecedent basis for this limitation in the claim. Examiner believes the system is referring to the database.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the variable X to mean some number of characters renders the claim indefinite. The use of the phrase "and/or" also renders the claim indefinite.

Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. It appears the Applicant has intended for the claim to be independent but has recited dependency to claim 1. Claim 6, is however a dependent claim and is being treated as a one. As such, a dependent claim should further limit the scope of its parent claim. Therefore, claim 6 should further limit the method of claim 1 and not a multi-key card. Similarly claims 7-8 also should refer back to the method to avoid internet fraud.

Furthermore in regards to claim 6, the phrases "a usual size", "X characters", and "may contain" renders the claim indefinite and creates a problem in determining the scope of the limitations.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP Application Publication 2006/0149675 to Kawamoto et al., hereinafter Kawamoto in view of USP 6,659,038 to Calcagno.

As per claim 1, Kawamoto teaches a method to avoid Internet fraud that is carried out by means of a multi-key card in which a business organization, one or more

users from the business organization and an authorization center interact, the method comprising the following steps (see abstract):

requesting the legitimizing of the business organization to operate with the authorization center; checking out the business organization in a database of the authorization center, assigning the business organization an identification code, said data base being not available on the Internet (Fig. 1, reference 1);

sending a list of the users to the authorization center (0009);

preparing a registry assigning each user an alias or NICK and loading the registry into the database so that the new users are accepted (0008);

requesting a specific number of multi-key cards for users qualified to operate by means of a note or purchase order (Fig. 2, S210);

generating in the authorization center a set consisting of the specific quantity of multi-key cards, assigning a unique number to each set and another unique number to each card, relating this card number with the user's NICK (0009);  
distributing the multi-key cards to the corresponding user (0009).

Kawamoto is silent in disclosing and the cards including a form that possesses an organic security seal where the user must sign and leave the user's fingerprint.

Calcagno teaches including a form that possesses an organic security seal where the user must sign and leave the user's fingerprint (Fig. 1). This known method provides verification that the intended user has received the card and can be proved. One of ordinary skill in the art would be motivated to use a method in which security is at the utmost importance. Therefore it would have been obvious to one of ordinary skill in the

art at the time of the invention to use the organic security seal of Calcagno as means of delivering the card issued by the authorization center.

Furthermore Kawamoto teaches updating information for the delivery of cards and returning the information and the form to the authorization center (0063);

qualifying the NICK of the user who has received the multi-key card, thus updating the cards qualified (0068); and

confirming the qualification to the recognized user, wherein the method further comprises the following steps to authenticate user identity through a web page: entering an official legitimized web page, the business organization requests entry to a portal of the authorization center by means of a link and, once entered therein, enters the NICK and a PIN of the multi-key card(0063);

converting via an authorization center network server the NICK and the PIN to a bar code, and sending the bar code to the database of the authorization center, the database being without an open connection where a laser reader Connected to the database reads the data and verifies whether the NICK is authorized, whether the PIN entered belongs to that NICK and whether the PIN entered has not been used before, authorizing the operation if all the verifications are positive or denying the operation if any of the verifications is negative (0063);

the server without open connection shows the verification result and sends the result to the network server, where another laser reader connected to the network server reads the verification result, authorizing or denying the user's requested operation (0075).



As per claim 2, Kawamoto teaches the following step for the authentication of user identity by means of a call center comprises:  
requesting legitimization as the user by means of a telephone call to the call center (0057-0058),  
in response to the call center operator the user reports the user's NICK and a PIN code from the user's multi-key card, data that will be entered by the operator into the system that makes the 15 verification of such data available (0059),  
the system verifies that the NICK is qualified, that the PIN corresponds to the NICK and that the PIN has not been used, authorizing the operation if all the verifications are positive or denying the authorization if any of the verifications is negative;  
once the verification has been effected, giving a response to the request for legitimization of identity to the user who requests it by telephone and invalidates further use of the NICK and PIN combination for a future operation (0075).

As per claim 3, Kawamoto teaches the PIN entered by the user has limited temporary validity (0081).

As per claim 4, Kawamoto teaches the PIN entered by the user has a color determined as a function of the category of the user who holds the card (0082).

As per claim 5, Kawamoto teaches generating the cards in sets and assigning to each a unique alphanumeric card code of X characters (numbers, capital letters and/or lower-case letters), the system verifying that there is no identical code in the database that are not available on the network (0063);

generating a random alphanumeric code of variable length that will be utilized as a PIN (0081);  
repeating the operation as many times as the multi-key card contains PINS so the system can verify that a PIN is not repeated in the same card (0081);  
assigning the user NICK to the code of the multi-key card and keeping the information in the database, thus authorizing this multi-key card (0081).

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamoto and Calcagno as applied to claim 1 above, and further in view of USP 7,134,594 to Thompson et al., hereinafter Thompson.

As per claim 6, Kawamoto and Calcagno are silent in teaching the security card being of a usual size as that of a magnetic card, having imprinted thereon the user's NICK, a variable series of PINs (alphanumeric codes) hidden by a scratch-off type protective cover, a unique set code identifier issued by the authorization center printer at the time of generating a specific set of cards for the business organization, and a card code identifier consisting of a unique alphanumeric code of X characters which identify that multi-key card, relating the card to the user and to the PINs that the user is authorized to use. Thompson teaches the security card being of a usual size as that of a magnetic card, having imprinted thereon the user's NICK, a variable series of PINs (alphanumeric codes) hidden by a scratch-off type protective cover, a unique set code identifier issued by the authorization center printer at the time of generating a specific

set of cards for the business organization, and a card code identifier consisting of a unique alphanumeric code of X characters which identify that multi-key card, relating the card to the user and to the PINs that the user is authorized to use (Fig. 1). It is obvious to incorporate known improvement in the art to similar devices. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine scratch off feature of Thompson with the security cards of Kawamoto.

As per claim 7, the combined system of Kawamoto, Calcagno, and Thompson teach that the NICK is printed on the multi-key card and hidden by a scratch-off type protective cover (Fig. 1 of Thompson).

As per claim 8, the combined system of Kawamoto, Calcagno, and Thompson teach the NICK is printed on a removable plastic strip (0002).

As per claim 9, the combined system of Kawamoto, Calcagno, and Thompson teach the multi-key card is wrapped in shrink-seal cellophane (0002).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in provided by the PTO-892 form enclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is

(571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2131

/Syed Zia/

Primary Examiner, Art Unit 2131